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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|-----------------------------|------------------|
| 10/621,765 | 07/17/2003 | Martin Kowalski | F-7890 | 1720 |
| 28107 | 7590 | 06/09/2006 | | |
| JORDAN AND HAMBURG LLP 122 EAST 42ND STREET SUITE 4000 NEW YORK, NY 10168 | | | EXAMINER JULES, FRANTZ F | |
| | | | ART UNIT 3617 | PAPER NUMBER |

DATE MAILED: 06/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-----------------|------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/621,765 | KOWALSKI, MARTIN | |
| | Examiner | Art Unit | |
| | Frantz F. Jules | 3617 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-12 is/are pending in the application.
- 4a) Of the above claim(s) 4-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,8-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1, 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 11, the word "depressions" is confusing as it is unclear how it relates to previously cited deep depressions above in line 9.

In claim 1, line 14, the phrase "said depressions" is confusing as it is unclear which particular ones of the numerous depressions recited above, applicant is referring to.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over The Prior Art drawing figs. 1-2.

The prior Art drawing figs. 1-2 discloses a concrete railroad tie comprising an elastic rail support; lateral, raised shoulders and a support region disposed between a base of a rail and said raised shoulders, the rail being longitudinally received in a crosswise

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direction of said plastic rail support; guide plates (6) including twisting prevention devices (5) disposed in said supporting region; a support area (3) for supporting said guide plates, said support area being flat as shown in the fig. 1, deep depressions beneath said guide plates (4); said support area includes outer edges (1), each of said outer edges comprising the depressions spaced apart in crosswise direction for preventing twisting, and said twisting-preventing devices of said guide plates comprising lugs (5), said lugs engaging respective ones of said depressions.

The prior art drawing figs. 1-2 discloses all of the features as disclosed above but does not disclose spaced apart depressions and spaced apart lugs engaging the depressions. The general concept of separating or dividing an existing structure into simpler components falls within the realm of common knowledge as obvious mechanical expedient which carry no patentable weight as suggested in MPEP 2144.04 (V) and the specific use of spaced apart lugs engaging spaced apart depression constitutes an obvious separation or duplication of parts. It would have been obvious to one of ordinary skill in the art at the time of the invention to one of ordinary skill in the art at the time of the invention to modify The Prior art drawing figs. 1-2 to include the use of spaced apart depressions and spaced apart lugs engaging the depressions in his advantageous concrete railroad tie in order to reduce lateral shifting of the rail thereby increasing safety of the railroad track.

Response to Arguments

5. Applicant's arguments filed 03/21/2006 have been fully considered but they are moot in view of the new ground of rejection.

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Applicant's amendment to the claims to incorporate among others the limitations of depressions "spaced apart in said crosswise direction" in the independent claims gave rise to the new grounds of rejection. Also, applicant's amendment of claim 1 causes the rejection of the claim under 112 2nd paragraph.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantz F. Jules whose telephone number is (571) 272-6681. The examiner can normally be reached on Monday-Thursday and every other Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph S. Morano can be reached on (571) 272-6684. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Frantz F. Jules
Primary Examiner
Art Unit 3617

FFJ

May 26, 2006

**FRANTZ F. JULES
PRIMARY EXAMINER**

A handwritten signature in black ink, appearing to read 'Frantz F. Jules', is written over a horizontal line. The signature is stylized with a large 'F' and a long horizontal stroke.